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05/12/2009

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EXAMINER

COLBERT, ELLA

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/175,589	Applicant(s) JACOBSON, ANDREA M.	
	Examiner Ella Colbert	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-14, 16-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-14, 16-19, and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14, 16-19, and 21-23 are pending. Claims 1, 5, 12, 13, 16, 17, 21, and 23 have been amended in this communication filed 10/13/08 entered as Response After Non-Final Action and Request for Extension of Time.
2. The Claim Objections from the prior Office Action for claims 1, 13, 17, and 23 have been overcome by Applicant's amendment to the claims and are hereby withdrawn.
3. The 35 USC 112, first paragraph rejection for claims 1, 5, 12, 13, 17, 21, 23 and the claims that depend there from still remains as set forth here below.
4. The 35 USC 112, second paragraph rejection from the prior Office Action for claims 13, 17, and the claims that depend there from is hereby withdrawn in view of Applicant's amendments to claims 13 and 17.
5. The Allowable subject matter from the prior Office Action is hereby withdrawn in view of the rejections as set forth here below.

Claim Objections

Claims 5, 12, and 21 are objected to because of the following informalities: Claim 5 recites the "network user registry" and the "network user profile". The recitation would be better recited as the "network user's registry" and the "network user's profile". Claims 12 and 21 have a similar problem. Claim 10 needs a period at the end of the last claim limitation. Appropriate correction is required.

Specification

The amendment filed 10/13/08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the Specification. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "Additionally, the Present Invention provides for an article of manufacture, comprising a computer-readable storage medium having a computer program embodied therein, for maintaining policy compliance on a computer network." Also, the Specification filed 03/20/07 is replete with new matter. Applicant is respectfully requested to compare the original Specification with this Specification for new matter. The only amendments that can be made are for spelling and grammatical errors and to add other applications by the Applicant and to correct drawing figure element numbers and to add a drawing figure number in the Specification. Virtually, any other additions to the Specification is considered new matter and are not allowed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 5, 12, 13, 16, 17, 21, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains

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subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 13, 17, and 23 recite "initiating the execution of the scripting code" and this limitation does not have sufficient support in the specification. The only reference found was to "the object's scripting language" on page 14, line 22, on page 15, line 8 "begin executing the scripting code within the application" and on page 19, line 17 "to generate a reference code" in the Specification. Claims 5, 12, 16, and 21 recite "registry" and this portion of the limitations is found but recites "network user's operating system registry" in the Specification. Also Claim 17 mentions "medium" and in the Specification "media and "storage media" are referenced on page 28, line 21; page 49, line 8 and page 50, lines 13-16 of the Specification. However, there is not any mention of a computer-readable storage medium having a computer program embodied therein ...".

Claims 2, 3, 6-12, 14, 16, 18, 19, and 22 are also rejected for their dependency on a rejected claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 13 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "specified time period". This

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recitation in the claim is vague, indefinite and varied. Claim 1 also recites "procedures for handling". This recitation in the claim is vague and indefinite.

Claims 5,12, 13, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: Claim 5 "network user's operating system registry". Claim 12 and 16 have a similar problem. Claim 13 after "deletion prevention" needs to have "specified" inserted in order to be in agreement with the other independent claims 1 and 17.

Claims 14-16, 18, 19, 21, and 22 are also rejected for their dependency on a rejected base claim.

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, and 5-11 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409

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U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1, 2, and 5-11 fail to meet the above requirements since there is not a sufficient tie to another statutory class.

Claims 17-19, 21, and 22 are rejected under 35 USC 101 because the computer program does not have computer executable instructions. In order for claim 17 to be statutory the computer program must have executable instructions. The computer program could just be text *per se*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over “<http://www.ustrim.com/trim/page 31.htm>”, hereafter ustrim in view of (US 6,108,688) Nielsen.

With respect to claim 1, USTrim teaches, creating an electronic tag that uniquely identifies the electronic record, the electronic tag being associated with a deletion prevention specified time period (See “Retention and Disposal of Records” page 1) for compliance with the network security policies (see “publishing records on the WWW” page 1 and “Security and Privacy of Records” page 1 and “Functional Security” pages 1 and 2); storing the at least one electronic tag in a central repository (see “Record

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Navigation” page 1, “WWW Access to TRIM DataBases” page 1, and “Publishing Records on the WWW” page 1).

Ustrim failed to teach, sending the electronic record from the distributed computing environment to a recipient. Nielsen teaches, sending the electronic record from the distributed computing environment to a recipient (col. 2, lines 57-66). It would have been obvious to one having ordinary skill in the art at the time the invention was made to send the electronic record from a distributed computing environment to a recipient and to modify in Ustrim in view of Ustrim’s teachings of an electronic tag and electronic documents and because such a modification would allow Ustrim to be addressed to a recipient and to arrive at the recipient’s computer terminal with minimal information about the message.

Ustrim teaches, initiating the execution of scripting code upon the sending of the electronic record from the distributed computing environment to the recipient, the scripting code containing the procedures for handling the electronic record, wherein the initiation of the execution of the scripting code prevents the electronic record from being deleted before expiration of the deletion prevention time period with the electronic tag (page 1, “Retention & Disposal of Records” (also see fig. of screen shot) and “Automatic Disposition Management” pages 1 and 2)). Ustrim did not expressly disclose initiating the execution of scripting code upon the sending of the electronic record from the distributed computing environment to the recipient, the scripting code containing the procedures for handling the electronic record, wherein the initiation of the execution of the scripting code prevents the electronic record from being deleted before expiration of

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the deletion prevention time period with the electronic tag. However, Ustrim shows in a figure of the screen shot of a 2 year archive and destroying after 6 years. Nielsen teaches, a date and time in fig. 2. It is well known in the art of electronic mail and network security that electronic mail documents are either deleted, purged, archived or destroyed after a period of time.

Claims 2-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ustrim and Nielsen in view of (EP 0346556) Mourier.

With respect to claim 2, Ustrim and Nielsen failed to teach, further comprising deleting the electronic record and selectively deleting the at least one electronic tag.

Mourier teaches, further comprising deleting the electronic record and selectively deleting the at least one electronic tag (col. 9, lines 47-55 and lines 59-68 and fig. 19B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to delete the electronic record and selectively delete the at least one electronic tag and to modify in UStrim because such a modification would allow UStrim to have the tag transferred into the "To Be Answered" file and deleted from the "To Be Assigned" file (purging the electronic record comprising the steps of deleting the electronic record).

With respect to claim 3, UStrim teaches, further comprising storing the electronic record ("WWW Access to Trim DataBase" page 1).

With respect to claim 5, Ustrim and Nielsen failed to teach, wherein the distributed computing environment comprises a computer having a network user

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registry and a network user user profile, and wherein creating the electronic tag comprises generating a reference code and creating the electronic tag at least in part as a function of at least one of the registry, the user profile, and the reference code.

Mourier teaches, wherein the distributed computing environment comprises a computer having a network user registry and a network user user profile, and wherein creating the electronic tag comprises generating a reference code and creating the electronic tag at least in part as a function of at least one of the registry, the user profile, and the reference code (col. 4, lines 12-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the distributed computing environment comprise a computer having a registry and a user profile, and wherein creating the electronic tag comprises generating a reference code and creating the electronic tag at least in part as a function of at least one of the registry, the user profile, and the reference code and to combine Ustrim's electronic tag that uniquely identifies the electronic record with Mourier's distributed computing environment comprising a computer having a registry and a user profile, and wherein creating the electronic tag comprises generating a reference code and creating the electronic tag at least in part as a function of at least one of the registry, the user profile, and the reference code because such a combination would allow Ustrim to manage electronic mail without wasteful memory space and without having a time-consuming process to retrieve saved electronic mail.

With respect to claim 6, UStrim and Nielsen failed to teach, generating the reference code comprises reading the electronic record. Mourier teaches, generating

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the reference code comprises reading the electronic record (page 7, lines 16-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate the reference code comprising reading the electronic record and to modify in UStrim because such a modification would allow Nielsen to have a special memory section within his machine, memory section he may access on a read/write basis.

With respect to claim 7, wherein the reference code comprises a classification code and an index code.

With respect to claim 8, UStrim and Nielsen failed to teach, wherein the classification code is selected from a group comprising business email, personal email, intrmail, bulletin board, minutemail, and purgemail. Mourier teaches, wherein the classification code is selected from a group comprising business email, personal email, intermail, bulletin board, minutemail, and purgemail. (page 7, lines 1-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the index code identify the contents of the electronic record and to modify in UStrim because such a modification would allow UStrim to have a command that sorts (index) the files by updated dates (index code).

With respect to claim 9, UStrim failed to teach, wherein the index code identifies the contents of the electronic record and the recipient of the electronic record. Nielsen teaches, wherein the index code identifies the contents of the electronic record and the recipient of the electronic record (col. Col. 1, lines 7-41). The nature of E-mail does not entitle any patentable weight and is considered a design choice.

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With respect to claim 10, UStrim and Nielsen failed to teach, wherein creating the electronic tag comprises: reading a stored electronic tag; and generating an electronic tag in response to accessing an electronic record. Mourier teaches, wherein creating the electronic tag comprises: reading a stored electronic tag; and generating an electronic tag in response to accessing an electronic record (Page 8, lines 9-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to read a stored electronic tag and generating an electronic tag in response to accessing an electronic record and to modify in UStrim because such a modification would allow UStrim to have a subject and to have a message with the sender code and a recipient code.

With respect to claim 11, UStrim discloses, wherein the electronic record comprises an email message (Pg. 1-Desktop trays- "tag and task" with drawing).

With respect to claim 12, UStrim discloses, wherein sending the electronic record comprises: reading the electronic tag; and generating a new electronic tag at least in part as a function of the read electronic tag, a network user registry, a network user user profile, and a reference code (Pg.'s 1 and 2-Publishing records on the www (World Wide Web)).

With respect to claim 13, UStrim and Nielsen failed to teach, a computer system comprising at least one processor and at least one memory. Mourier teaches, a computer system comprising at least one processor and at least one memory (page 3, lines 1-18 and lines 46-49), the computer system being adapted and arranged to create an electronic tag that uniquely identifies the electronic record, the electronic tag being

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associated with a deletion prevention time period for compliance with the network security policies; a central respository adapted to store the electronic tag; the distributed computing environment being adapted to send the electronic record to a recipient; and scripting code, contained within the electronic tag, which is initiated and executed upon the sending of the electronic record from the distributed computing environment to the recipient, the scripting code containing the procedures for handling the electronic record, wherein the initiation of the execution of the scripting code prevents the electronic record from being deleted before expiration of the deletion prevention time period associated with the electronic tag. This independent claim is rejected for the similar rationale as given above for claim 1.

The following examples of language in a claim that may raise a question as to the limiting effect of the language in a claim are: (A) statements of intended use or field of use, (B) "adapted to" or "adapted for" clauses, (C) "wherein" clauses, or (D) "whereby" clauses. The list of examples is not intended to be exhaustive." MPEP 2106 II C.

"A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if the prior art has the capability to so perform." MPEP 2114 and *Exparte Masham*, 2 USPQ2d 1647 (1987).

"While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of

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structure rather than function alone.” MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

With respect to claim 14, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 15, this dependent claim is rejected for the similar rationale given for claim 4.

With respect to claim 16, this dependent claim is rejected for the similar rationale given for claim 5.

With respect to claim 17, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 19, this dependent claim is rejected for the similar rationale given for claim 3.

With respect to claim 20, this dependent claim is rejected for the similar rationale as given above for claim 4.

With respect to claim 21, this independent claim is rejected for the similar rationale given for claim 5.

With respect to claim 22, this independent claim is rejected for the similar rationale given for claim 6.

With respect to claim 23, this independent claim is rejected for the similar rationale as given above for claims 1, 13, and 17.

Response to Arguments

Applicant's arguments filed 10/31/08 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: Applicant respectfully traverses the Examiner's rejection that "the initiation of the execution of the scripting code" does not have sufficient support in the Specification because the phrase "scripting code" is first introduced at pg. 14, line 22, and further, the Specification notes at pg. 15, line 1, that the "scripting" language contains the procedures for handling the e-mail message and later, on pg. 15, line 8 the Specification refers to "scripting code" has been considered but is not persuasive. Response: The Examiner respectfully disagrees, because Pg. 14, line 22 recites "reference number may be used by the system 140 to index and track the mail in the"; Pg. 15, line 1 recites "system 140 copying the email message and its electronic tag. The process is similar to".; and Pg. 15, line 8 recites "system storing the email messages in the central repository database 150. Block 212" according to the Specification in the application file

Issue no. 2: Applicant argues: Applicant respectfully traverses the Examiner's rejection of the term "registry" because it is first introduced at Pg. 18, line 9 and on Pg. 35, line 8 again in the Specification. Response: The Examiner respectfully disagrees because Pg. 18, line 9 recites "Block 611 represents the system 140 reading the object's script" and Pg. 35, line 8 recites "module. The e-mail records retention module typically provides system administrators" according to the Specification in the application file.

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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

“Claims in a pending application should be given their broadest possible interpretation”. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

“An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...”. *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

May 11, 2009